

REMARKS

Claims 1, 4, 5, and 21 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Claims 1, 4-5, 15-21, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Number 5,018,060 to Gelb et al. (hereinafter Gelb) in view of United States Patent Number 5,757,571 to Basham et al. (hereinafter Basham) and in further view of United States Patent Publication 2003/0193994 by Stickler (hereinafter Stickler).

Claims 7, 10, 12, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and Stickler and in further view of United States Patent Application Publication Number 2003/0204672 by Bergsten (hereinafter Bergsten). Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham, Stickler, and Bergsten and in further view of “Active Storage for Large-Scale Data Mining and Multimedia” Proceedings of the 24th VLDB Conference, New York, USA, 1998 by Erik Riedel et al. (hereinafter Riedel). Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham, Stickler, and Bergsten, and in further view of United States Patent Publication 2003/0120379 by Mehlberg et al. (hereinafter Mehlberg).

Response to rejections of claims under 35 U.S.C. § 101

Claims 1, 4, 5, and 21 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicants request that amendments to claims 1, 4, and 5 be allowed to direct claims 1, 4, 5, and 21 to statutory subject matter. Applicants had assumed after the Office Action of April 10, 2007 that the claims as amended were directed to statutory subject matter under 35 U.S.C.

§ 101 and have not had a prior opportunity to respond to this particular rejection. Specifically, Applicants request that claims 1, 4 and 5 be amended with the limitation that each module is “...implemented in software stored on a memory device for execution on a processor...” The amendment is well supported by the specification. See page 8, ¶ 28.

Response to rejections of claims under 35 U.S.C. § 103(a)

Claims 1, 4, 5, 15-21, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and in further view of Stickler. Claims 7, 10, 12, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham and Stickler and in further view of Bergsten. Claims 13 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham, Stickler, and Bergsten and in further view of Riedel. Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gelb in view of Basham, Stickler, and Bergsten, and in further view of Mehlberg. Applicants respectfully traverse these rejections.

Claims 1, 7 and 15 as amended include the limitations “...receive a dataset for storage on a magnetic tape storage medium with a storage instruction that does not direct that the dataset is stored with scaling...” and “...select a scaling storage instruction in response to storage criteria applied to the storage characteristics that indicate scaling is beneficial and communicate the selected scaling storage instruction to a storage controller, wherein the scaling storage instruction comprises an instruction to scale the magnetic tape storage medium to a predefined capacity for optimal data access performance and the storage controller stores the dataset on a magnetic tape

storage device in response to the scaling storage instruction...” Claim 1. See also claims 7 and 15. Thus the present invention claims selecting a scaling storage instruction in response to storage criteria applied to storage characteristics that indicate scaling is beneficial for a dataset received with a storage instruction that does not direct that the dataset is stored with scaling.

The Examiner argues that Gelb’s teaching of allocating a dataset to a non-SMS managed portion of the data processing system is analogous to receiving a dataset for storage on a magnetic tape storage medium with a storage instruction that does not direct that the dataset is stored with scaling. Office Action of Feb 21, 2008 (hereinafter OA080221), page 4, lines 8-10; page 20, line 16 – page 21, line 13. The Examiner further cites Basham’s teaching of storing data sets in scaled partitions as disclosing selecting a scaling instruction. OA080221, page 6, lines 18-21.

Applicants respectfully submit that Gelb, Basham, Stickler, and Bergsten do not disclose selecting a scaling storage instruction in response to storage criteria applied to storage characteristics that indicate scaling is beneficial for a dataset received with a storage instruction that does not direct that the dataset is stored with scaling. Gelb does teach selecting a storage class. Gelb, col. 18, lines 64 – col. 19, line 15; fig. 7, ref. 42. However, Gelb does not teach selecting a scaling instruction in response to storage criteria applied to storage characteristics that indicate scaling is beneficial. OA080221, page 6, lines 3-10. The Examiner relies on Basham for this limitation. OA080221, page 6, lines 11-18.

However, Basham teaches away from selecting a scaling storage instruction in response to storage criteria applied to storage characteristics that indicate scaling is beneficial for a dataset

received with a storage instruction that does not direct that the dataset is stored with scaling.

Basham teaches storage segments for scaling are defined prior to using a magnetic tape. Basham, col. 2, lines 53-55. Thus scaling is imposed on all stored datasets rather than scaling commands being selected in response to storage criteria.

In addition, an application may require assorted sizes of fixed-size partitions. Basham, col. 11, lines 25-29. Thus datasets may be communicated with scaling commands. However, Basham does not teach selecting a scaling storage instruction in response to storage criteria applied to storage characteristics that indicate scaling is beneficial for a dataset received with a storage instruction that does not direct that the dataset is stored with scaling. Specifically, there is no mention of selecting scaling when a dataset is received with a scaling instruction that does not direct scaling. Therefore Basham, and also Gelb, Stickler, and Bergsten do not teach all of the elements of the present invention.

Applicants therefore submit that claims 1, 7, and 15 are allowable. Applicants further submit that claims 4, 5, 10, 12-14, and 16-24 are allowable as depending from allowable claims.

Conclusion

As a result of the preceding amendments and remarks, Applicants submit that the application is in condition for prompt allowance. Should additional information be required regarding the traversal of the rejections of the claims enumerated above, Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

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